REMARKS

Claims 1-22 are pending in this application.

Claims 1-8, 12-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,499,294 to Friedman ("Friedman") in view of U.S. Patent No. 5,875,249 to Mintzer et al. ("Mintzer").

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Friedman in view of Mintzer in further view of U.S. Patent No. 5,799,082 to Murphy et al. ("Murphy").

Claims 10-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Friedman in view of Mintzer and in further view of U.S. Patent No. 5,335,072 to Tanaka et al ("Tanaka").

It is respectfully submitted that the above claim rejections are legally deficient because under 35 U.S.C. § 103(c), the Mintzer reference is not available as prior art against the claimed invention. More specifically, under amended provision 35 U.S.C. §103(c), commonly assigned applications that are available as prior art only under 35 U.S.C. §102(e), (f) or (g) are no longer applicable as prior art to the claimed invention in an obviousness rejection. In particular, 35 U.S.C. §103(c) was amended to recite:

> Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person.

(Emphasis added). See also 1233 OG 55-56 (April 11, 2000), which describes guidelines to implement amended §103(c).

Further, as set forth in MPEP 706.02(l)(1), for applications filed on or after November 29, 1999 (including continued prosecution applications (CPA) filed under 37 CFR 1.53(d)),

subject matter that was 35 U.S.C. 102(e) prior art under former 35 U.S.C. 103 is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. The mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application.

Here, the provisions of 35 U.S.C. 103(c) are applicable to disqualify the Mintzer reference as prior art against the claimed inventions for the following reasons.

First, Mintzer is available as prior art to the present application *only* under 35 U.S.C. §102(e). Indeed, the Mintzer patent was issued on February 23, 1999, which is *after* the effective filing date of Applicants' current application, May 18, 1998.

Secondly, a CPA for Applicants' current application is being filed concurrently herewith. Therefore, the CPA filing date is *after* the effective date of November 29, 1999. Accordingly, the amended provision 103(c) can be applied to the current obviousness rejections.

Thirdly, for purposes of c*ommon ownership*, the current application and the Mintzer patent were, at the time the invention of the current application was made, owned by the same entity, International Business Machines Corporation.

Therefore, for the above reasons, Examiner cannot rely on the Mintzer patent in support of the current claim rejections under 35 U.S.C. 103(a). Accordingly, each of the claim rejections under 35 U.S.C. 103(a) are legally deficient on their face and, consequently, must be withdrawn.

In view of the foregoing remarks, it is respectfully submitted that all the claims now pending in the application are in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

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